



PATENT
HER07 P-107

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Serial No. : 09/710,769 Confirmation No.: 5666
Applicants : Thomas Gebele, Jürgen Henrich,
Stefan Bangert, Jürgen Honekamp,
Dr. Elisabeth Budke, Jürgen Ulrich
and Dr. Helmut Grimm
Filed : November 9, 2000
Group : 1763
Examiner : Parviz Hassanzadeh
For : ELECTRODE ARRANGEMENT
Atty Docket No. : HER07 P-107
Customer No. : 28101

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

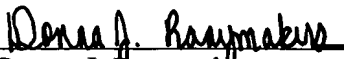
Dear Sir:

CERTIFICATE OF MAILING

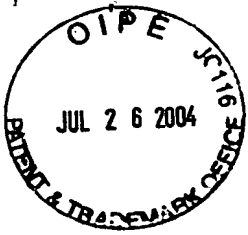
I hereby certify that this paper together with the attached Appellants' Reply Brief (37 C.F.R. 1.193(b)(1)) (4 pages), including cover sheet (1 page) and Table of Contents (1 page); (cover sheet, Brief, Table of Contents are submitted in triplicate); Appellants' Reply Brief (37 C.F.R. 1.193(b)(1)) letter (1 page); Transmittal of Appellants' Reply Brief (1 page, in duplicate); and return postcard are being deposited with the United States Postal Service as first class mail, postage fully prepaid, in an envelope addressed to:

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P.O. Box 1450
Alexandria, VA 22313-1450

on July 21, 2004.


Donna J. Raaymakers
Van Dyke, Gardner, Linn & Burkhart, LLP
2851 Charlevoix Drive, S.E., Suite 207
Post Office Box 888695
Grand Rapids, Michigan 49588-8695
(616) 988-4108

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Dear Sir:

TRANSMITTAL OF APPELLANTS' REPLY BRIEF

Transmitted herewith in triplicate is the APPELLANTS' REPLY BRIEF (37 C.F.R. 1.193(b)(1)) in this application with respect to the Examiner's Answer mailed on May 24, 2004.

If any fee is required, this is a request therefor to charge Deposit Account No. 22-0190. A duplicate copy of this Transmittal of Appellants' Reply Brief is attached.

Respectfully submitted,

THOMAS GEBEL ET AL.

By: Van Dyke, Gardner, Linn & Burkhardt, LLP

Frederick S. Burkhardt
Registration No. 29 288
2851 Charlevoix Drive, S.E., Suite 207
Post Office Box 888695
Grand Rapids, Michigan 49588-8695
(616) 988-4104

Dated: July 21, 2004.

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Dear Sir:

APPELLANTS' REPLY BRIEF (37 C.F.R. 1.193(b)(1))

This Reply Brief is in furtherance of the Examiner's Answer mailed in this case on May 24, 2004. Any fees, which may be required for filing this Brief, are dealt with in the accompanying TRANSMITTAL OF APPELLANTS' REPLY BRIEF.

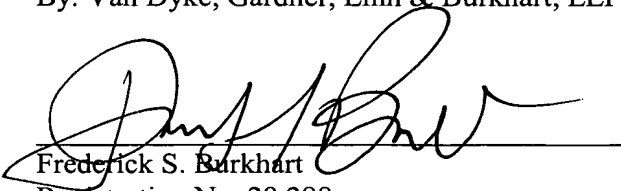
This Brief is transmitted in triplicate.

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Dated: July 21, 2004.


Frederick S. Burkhardt

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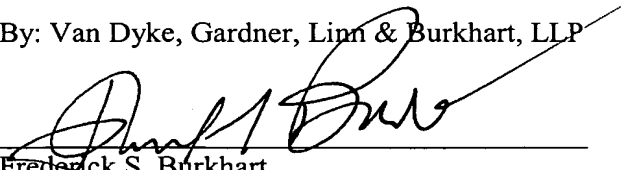
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Respectfully submitted,

THOMAS GEBELE, JÜRGEN HENRICH,
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Frederick S. Burkhardt

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TABLE OF CONTENTS

	<u>Page</u>
1. SECTION 7	1, 2
2. SECTION 8	2-4
3. CONCLUSION.....	4



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Dear Sir:

APPELLANTS' REPLY BRIEF (37 C.F.R. 1.193(b)(1))

This Reply Brief is being filed in response to the Examiner's Answer mailed May 24, 2004, in the above-identified matter. The following comments are being offered in response to several new points raised in the Examiner's Answer. While the Applicants have not responded to each and every new point raised by the Examiner, this should in no way be construed as an admission to the alleged correctness of the Examiner's position. Rather, Applicants have chosen only to respond to those arguments which Applicants consider to not be fully rebutted in Applicants' principle Appeal Brief. The following heading sections correspond to the headings in Applicants' principle Appeal Brief.

7. The Examiner's Answer states that Applicants' Brief allegedly contains an improper grouping of claims. Specifically, it is contended that the rejection of all of the claims 1, 13, 14, 17 and 25-27 stand or fall together because Applicants' Brief did not include a statement that this grouping of claims does not stand or fall together and reasons in support

thereof. Applicants respectfully disagree. Page 5 of Applicants' Brief states that claims 25-27 shall stand or fall together separate from the other claims. Further, separate reasons for each of the claims in these groups are provided in the Argument section of Appellants' Brief. Accordingly, Appellants' Brief correctly identifies each of the groups of claims that stand or fall together and reasons in support thereof and each of these groups should be considered independently of each other.

8.I. The Examiner's Answer withdraws the rejection with respect to claims 2-6, 11, 12, 15 and 16 under 35 U.S.C. § 112, second paragraph, and has allowed these claims.

8.II. The Examiner's Answer distorts the disclosure of Akamatsu et al. Japanese Patent Publication No. 11-100661 A and ignores positively recited claim limitations. Claim 1 specifies that the gas supply supplies protective gas to the evaporation-active part of the cathode material surface. This claim limitation is ignored by the Examiner. The Examiner's Answer does not allege that the protective gas is supplied in Akamatsu et al. to the evaporation-active part of the cathode material surface. Rather, the Examiner merely states that "the flow of the gas extending from the cathode toward the anode would inherently protect the surface of the cathode bracket being contaminated by anode material present in the discharge." This limitation is clearly missing from Akamatsu et al. Even if the reference achieves the same beneficial results as the claimed invention, which is not conceded, the claim limitations must still be met.

Applicants disagree with the manner in which the Examiner applies the sparse disclosure of the cathode section 2 of Akamatsu et al. The Examiner equates the unnumbered box around electrode 5 (which the Examiner now names "enclosure 2" even though the number 2 in Akamatsu et al. refers to the cathode section) with the baffle claim limitation. The Examiner then applies the passage between "enclosure 2" and chamber 1 to meet *both* the "baffle opening" and the "intermediate space" claim limitations. This is improper. The claim requires that the supplied protective gas escapes at least partially through the baffle opening . . . *from* the intermediate space between the cathode material surface and the baffle arrangement. The gas cannot escape through one area *from* another area if these areas are the same. Once again, the Examiner is giving no weight to positively recited claim limitations.

Claim 1 also specifies at least a first and a second material component which produces a plasma discharge, the anode arrangement defines the first material component and the cathode arrangement defines the second material component. As discussed in the present specification, for example, beginning at page 6, line 33 through page 7, line 6, this allows particles evaporated from the cathode material surface to combine with particles evaporated from the anode arrangement. The Examiner has not pointed to any disclosure of Akamatsu et al. that meets the second material limitation of claim 1. Moreover, it is submitted that Akamatsu et al. does not disclose the cathode plate 5 serving as a material supply. Cathode plate 5 is merely a cathode in Akamatsu et al.

Applicants' respectfully urge that claims 1, 13, 14 and 17 are patentable under 35 U.S.C. § 102(b).

8.III. The Examiner dismisses claims 26 and 27 on the basis that the particular type of material used is a process limitation rather than an apparatus limitation, and the recitation of a particular type of material does not limit an apparatus claim. The Examiner mischaracterizes these claims. Claim 26 recites that the first material component comprises silicone. Claim 27 recites that the second material component comprises one of copper, zinc, brass and magnesium. These are not process limitations. These are further specifications of elements that are positively recited in claim 1. The case citations by the Examiner pertain to whether the material intended to be worked by a claimed apparatus imposes any structural limitations upon the claimed apparatus. That is different from the present matter where the material components are a positively recited elements of the electrode arrangement.

The Examiner further takes the position that the apparatus structure taught by Akamatsu et al. has the inherent capacity of being used in the manner intended by Applicants' claims 25 and 26. However, in relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristics *necessarily* flows from the teachings of the applied prior art. Manual of Patent Examining Procedure, Section 2112. The Examiner has given no rationale whatsoever why the elements of claims 26 and 27 are inherently disclosed by Akamatsu et al. Rather, this is another example of the Examiner ignoring positively recited claim limitations. As discussed above, Akamatsu et al. does not disclose the limitation of the cathode arrangement defining the second material component. Therefore, Akamatsu et al. certainly does not inherently disclose a particular material for the second material component.

Applicants' respectfully urge that claims 25-27 are patentably distinguishable over the cited references.

Conclusion

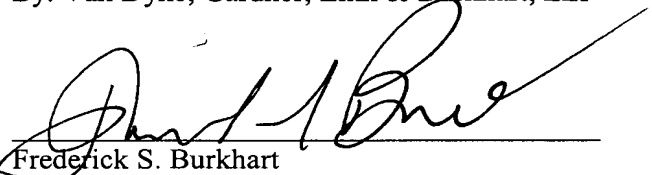
For all of the foregoing reasons, as well as the reasons in Appellants' principle Appeal Brief, the rejection of claims 1, 13, 14, 17 and 25-57 should be withdrawn.

Respectfully submitted,

THOMAS GEBELE, JÜRGEN HENRICH,
STEFAN BANGERT, JÜRGEN HONEKAMP,
DR. ELISABETH BUDKE, JÜRGEN ULRICH
and DR. HELMUT GRIMM

By: Van Dyke, Gardner, Linn & Burkhart, LLP

Dated: July 21, 2004.

A handwritten signature in black ink, appearing to read "Frederick S. Burkhart", is written over a horizontal line.

Frederick S. Burkhart
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